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OFFICE OF PETITIONS

In re Application of :
Hing et al. :
Application No. 09/787,922 : ON PETITION
Filed: 13 June, 2002 :
Atty Dckt No. HING3001/REF :

This is a decision on the petitions to withdraw the holding of abandonment under 37 CFR 1.181 and to revive the above-identified application under 1.137(b),¹ filed on 27 April, 2005.

The petition to withdraw the holding of abandonment is **DISMISSED**.

The petition to revive is **GRANTED**.

¹Effective December 1, 1997, the provisions of 37 CFR 1.137(b) now provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(b). A grantable petition filed under the provisions of 37 CFR 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof. In an application abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee.

(2) the petition fee as set forth in 37 CFR 1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and

(4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c)).

This application became abandoned on 24 March, 2005, upon dismissal of applicants' appeal to the Board of Patent Appeals and Interferences (BPAI) in response to the Request for Continued Examination (RCE) requested filed on 9 March, 2005. The RCE request indicated that an IDS was the required submission. As there were no allowed claims, the application is considered abandoned per MPEP 1215.01. Notice of Abandonment was mailed on 1 April, 2005.

PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT

Petitioners assert that the holding of abandonment was improper because the arguments in the appeal and reply briefs were of record, although the briefs had not been incorporated in the RCE because applicant failed to check the box on the RCE transmittal form incorporating the arguments in the Appeal and/or Reply Briefs. Petitioners state, specifically, "[i]t is not seen how failure to check this box negates the appropriate action taken to file an RCE with an IDS and the required fee. To do so is a clear misinterpretation of the rules."

MPEP 706.07(h) states, in pertinent part:

A "submission" as used in 37 CFR 1.114 includes, but is not limited to, an information disclosure statement, an amendment to the written description, claims, or drawings, new arguments, or new evidence in support of patentability. See 37 CFR 1.114(c). If a reply to an Office action under 35 U.S.C. 132 is outstanding, the submission must meet the reply requirements of 37 CFR 1.111. See 37 CFR 1.114(c). Thus, an applicant may file a submission under 37 CFR 1.114 containing only an information disclosure statement (37 CFR 1.97 and 1.98) in an application subject to a notice of allowance under 35 U.S.C. 151 **>, but not in an application where the last Office action is a final rejection or an Office action under Ex parte Quayle, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935), or in an application that is under appeal. A request for a suspension of action, an appeal brief or a reply brief (or related papers) will not be considered a submission under 37 CFR 1.114. See 37 CFR > 1.103 and < 1.114(d). The submission, however, may consist of the arguments in a previously filed appeal brief or reply brief, or may simply consist of a statement that incorporates by reference the arguments in a previously filed appeal brief or reply brief. In

addition, a previously filed amendment after final (whether or not entered) may satisfy this submission requirement.

Petitioners' argument has been carefully considered, but is not persuasive. In not checking the box indicating as such, petitioners clearly did not incorporate by reference the arguments in the previously filed briefs. While the Office understands that applicants' failure to check the box may have been an inadvertent mistake, it is a mistake nonetheless. Moreover, as petitioners submission concededly did not contain a statement incorporating by reference the arguments in the briefs, the RCE request clearly fails to comply with the patent rules and procedures. Therefore, the application was properly held abandoned. Since the abandonment was not due to Office error, but rather an error on the part of petitioners, the petition to withdraw the holding of abandonment must be dismissed.

PETITION UNDER 37 CFR 1.137(b) .

The present petition is accompanied by a corrected RCE Transmittal incorporating the arguments of the previously filed appeal and/or reply briefs.

The petition is granted.

The application file is being referred to Technology Center Art Unit 1731 for further processing.

Telephone inquiries concerning this matter may be directed to the undersigned at (571)272-3231.



Douglas I. Wood
Senior Petitions Attorney
Office of Petitions